

REMARKS

This is a full and timely response to the non-final Official Action mailed **April 21, 2008** (the "Office Action" or "Action"). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

Claim 15 was cancelled previously without prejudice or disclaimer. By the forgoing amendment, various claims have been amended, and claim 4 has been cancelled without prejudice or disclaimer. New claim 24 has been added. Thus, claims 1-3, 5-14 and 16-24 are currently pending for further action.

Allowable Subject Matter:

In the outstanding Office Action, the Examiner allowed claims 22 and 23. Applicant wishes to thank the Examiner for the allowance of these claims.

Additionally, the Examiner further indicated the presence of allowable subject matter in claim 4. Again, Applicant wishes to thank the Examiner for this identification of allowable subject matter.

The recent Office Action also contains a statement of reasons for the allowance or allowability of claims 4, 22 and 23. Applicant agrees with the Examiner's conclusions regarding patentability, without necessarily agreeing with or acquiescing in the Examiner's reasoning. In particular, Applicant believes that the application is allowable because the prior art fails to teach, anticipate or render obvious the invention as claimed, independent of how the claims or claimed subject matter may be paraphrased.

In accordance with the Examiner's finding of allowable subject matter in claim 4, claim 1 has been amended herein to include all the recitations of allowable claim 4, which has been cancelled. Consequently, following entry of this amendment, claim 1 and its dependent claims should be clear condition for allowance based on the allowable subject matter identified by the Examiner.

Rejection under 35 U.S.C. § 102:

Claims 1-3 and 6-12 were rejected as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,400,902 to Kaminski ("Kaminski"). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 1:

As noted above, claim 1 has been amended herein to include all the recitations of allowable claim 4, which has been cancelled. Consequently, following entry of this amendment, claim 1 and its dependent claims should be clear condition for allowance based on the allowable subject matter identified by the Examiner.

Claim 11:

Independent claim 11 has been amended herein to recite:

A storage compartment comprising:
a bottom and a sidewall that define an interior; and
a post operable to retain a storage disc in said interior, and including,
 a body operable to engage the storage disc; and
 a coupling element operable to allow the body to be positioned relative to the bottom in at least two different positions that include a first position in which the body can receive the storage disc when the disc is stored in the compartment, and a second position in which the body can not receive the storage disc,

wherein said coupling element comprises a hinge that allows said body to rotate at a base of the body between said first position in which said body is extending from said bottom of the storage compartment and said second position in which said body lays below said bottom of the storage compartment in a receptacle.

(Emphasis added).

Support for the amendment to claim 11 can be found in Applicant's originally filed specification at, for example, paragraphs 0022 and 0023, and Figs. 2 and 4.

In contrast, Kaminski clearly fails to teach or suggest the claimed coupling element that comprises *a hinge* that allows the body to *rotate at a base of the body* between two different positions, "said first position in which said body is extending from said bottom of the storage compartment and said second position in which said body lays below said bottom of the storage compartment in a receptacle." To the contrary, as clearly shown in Fig. 5 of Kaminski, there is no hinge. Rather, a disc (31) is engaged by "claim arms" (36). When pressure is applied to a flexible support (60) that supports the clamp arms (36), the flexible support (60) and clamp arms (36) deform and disengage from the disc (31) being stored.

The clamp arms (36) are not, however, disposed on a hinge and *never* rotate on such a hinge to the claimed second position in which they lay "below said bottom of the storage compartment in a receptacle." (Claim 1). In fact, as shown in Figs. 3 and 5 of Kaminski, whether engaged or disengaged, the clamp arms (36) always extend above the bottom of the storage compartment.

Thus, Kaminski fails to teach or suggest the claimed storage compartment comprising a post and coupling agent "wherein said coupling element comprises a hinge that allows said body to rotate at a base of the body between said first position in which said body is extending from said bottom of the storage compartment and said second position in which said body lays below said bottom of the storage compartment in a receptacle." "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is

found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the rejection based on Kaminski of claim 1 and its dependent claims should be reconsidered and withdrawn.

Additionally, various dependent claims of the application recite subject matter that is further patentable over the cited prior art. For example, claim 12 recites “the coupling element includes a locking element operable to retain the body in at least one of the positions.” Kaminski fails to teach or suggest this subject matter. For at least this additional reason, the rejection of claim 12 should be reconsidered and withdrawn.

Rejection under 35 U.S.C. § 103:

Claim 21:

Claim 21 was rejected under 35 U.S.C. § 103(a) over the combined teachings of U.S. Patent No. 6,535,379 to Smeenge, Jr. et al. (“Smeenge”) and Kaminski. For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 21 recites:

A computer system comprising:

 a housing having a storage compartment to retain an item and including:

 a bottom and a sidewall that define an interior, and

 a post operable to retain a storage disc, and having:

 a body operable to engage the storage disc; and

 a coupling element operable to couple the body to the bottom of the storage compartment and to allow the body to be positioned relative to the bottom in at least two different positions that include a position in which the body can receive the storage disc when the disc is stored in the compartment, and a position in which the body can not receive the storage disc and *in which the body remains without exerting pressure on the body*; and

a processor disposed in the housing.
(Emphasis added).

Thus, as recited in claim 21, no bias or pressure is required to be exerted on the body in order for it to remain in the retracted position in which it “cannot receive the storage disc.” This subject matter is not taught or suggested by the combination of cited prior art.

Smeenge teaches a computer enclosure with a storage compartment. However, according to the Office Action, Smeenge “is silent as to [the claimed] coupling element” that allows the body to be positioned in at least two different positions. (Action, p. 4). Consequently, the Action cites to Kaminski for a teaching of the claimed coupling element. (Action, p. 5).

As noted above, claim 21 specifically calls for a coupling agent that allows “the body to be positioned relative to the bottom in at least two different positions,” where a retracted position in one “in which the body can not receive the storage disc” and “and in which the body remains without exerting pressure on the body,” i.e., without any bias or force being exerted to keep the body in that retracted position. Kaminski’s teachings are directly contrary to this subject matter.

As discussed above, Kaminski teaches that a disc (31) is engaged by “claim arms” (36). (Kaminski, Fig. 5). When pressure is applied to a flexible support (60) that supports the clamp arms (36), the clamp arms (36) deform and disengage from the disc (31) being stored. However, the clamp arms (36) *will not* remain in this retracted position without a continual force being applied as shown in Kaminski’s Fig. 5. Rather, as soon as no force is exerted, the flexible support (60) will bias the clamping arms (36) back into an extended position (as shown in Fig. 3) where they can receive and engage the disc (31) to be stored.

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Smeenge and Kaminski, did not include the subject matter of claim 21, specifically the claimed coupling element that allows “the body to be positioned relative to the bottom in at least two different positions that include a position in which the body can receive the storage disc when the disc is stored in the compartment, and a position in which the body can not receive the storage disc *and in which the body remains without exerting pressure on the body.*” (Emphasis added).

These differences between the cited prior art and the claimed subject matter are significant. For example, Applicant had disclosed and claimed a computer system with a storage compartment that can either include a post for receiving a storage disc or have the post positioned out of the way so that storage space for other items can be maximized. (Applicant’s specification, paragraphs 0004 and 0005). Having the post unbiased to the extended position, so that it remains retracted without pressure being exerted, clearly facilitates the goal of storing other items in the storage compartment without interference from the post, while still having the post available when discs are to be stored. These advantages are not only not available with the cited prior art, but Kaminski expressly teaches away from this claimed subject matter.

Consequently, the cited prior art will not support a rejection of claim 21 under 35 U.S.C. § 103 and *Graham*. For at least these reasons, the rejection of claim 21 should be reconsidered and withdrawn.

Claim 14:

Claims 5, 13, 14 and 16-20 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Kaminski and U.S. Patent No. 6,799,677 to Marsilio et al. (“Marsilio”). For at least the following reasons, this rejection should also be reconsidered and withdrawn.

Claim 14 recites:

A method for storing a storage disc, the method comprising:
rotating a body of a post around *a hinge* attached to said post, wherein said body of said post is rotated between an extended position extending from a side of a storage compartment and a retracted position in which the body is disposed in a receptacle in said side of the storage compartment and can not receive the storage disc; and,
when said body of said post is in said extended position, engaging a hole in the disc with the body.
(Emphasis added).

Support for the amendment to claim 14 can be found in Applicant’s originally filed specification at, for example, paragraphs 0022 and 0023, and Figs. 2 and 4.

In contrast, as demonstrated above, Kaminski fails to teach or suggest “rotating a body of a post around a hinge attached to said post, wherein said body of said post is rotated between an extended position extending from a side of a storage compartment and a retracted position in which the body is disposed in a receptacle in said side of the storage compartment and can not receive the storage disc.” Kaminski clearly does not teach or suggest the claimed method including “rotating a body of a post around a hinge” between extended and retracted positions.

In this regard, the teachings of Marsilio are essentially the same as those of Kaminski. Like Kaminski, Marsilio fails to teach or suggest the claimed post on a hinge or the claimed method of rotating a body of a post around a hinge “wherein said body of said post is rotated between an extended position extending from a side of a storage compartment and a retracted

position in which the body is disposed in a receptacle in said side of the storage compartment and can not receive the storage disc.”

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Kaminski and Marsilio, did not include the claimed method of rotating a body of a post around a hinge between extended and retracted positions. As noted above, this subject matter provides advantages that were not recognized or available with the cited prior art. Consequently, the cited prior art will not support a rejection of claim 14 under 35 U.S.C. § 103 and *Graham*.

Additionally, claim 16 recites “retaining the body in at least one position with a locking element.” None of the cited prior art references teach or suggest this subject matter.

Claim 17 recites “supporting the disc away from the side with a support element on said body of said post.” In contrast, in both Kaminski and Marsilio, the disc is in contact with the storage compartment and not supported away from a side of the storage compartment by a support element on the body of the post as claimed.

Claims 19 and 20 respectively recite “wherein said body comprises two separate members” and “wherein rotating the body of the post into the extended position further comprises rotating the two separate member of the body in different directions, away from each other to place both in said receptacle.” This subject matter is clearly not taught or suggested by the cited prior art.

For at least these reasons, at least these dependent claims are clearly further patentable over the cited prior art. Notice to that effect is respectfully requested.

The newly added claim, claim 24, is thought to be patentable over the prior art of record for at least the same reasons given above with respect to the original independent claims. Therefore, examination and allowance of the newly added claim is respectfully requested.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the

Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Steven L. Nichols', written over a horizontal line.

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